

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	McGowan <i>et al.</i>	Conf. No.:	2034
Serial No.:	10/632,072	Art Unit:	2152
Filing Date:	07/31/2003	Examiner:	Whipple, Brian P.
Title:	METHOD, SYSTEM AND PROGRAM PRODUCT FOR PRESERVING AND RESTORING MOBILE DEVICE USER SETTINGS	Docket No.:	RSW920030088US1 (IBMR-0038)

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants respectfully request a panel of experienced examiners perform a detailed review of appealable issues for the above-identified patent application pursuant to the Pre-Appeal Brief Conference Pilot Program. Applicants submit that the above-identified application is not in condition for appeal because the Office has failed to establish a prima facie case of obviousness based on an error in facts. Claims 1-40 are pending in this application.

Turning to the rejection, in the Final Office Action, In the Office Action, claims 1-5, 7-13, 15-17, 20-26, 28-31 and 33-39 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Lenz (U.S. Patent No. 6,029,196), hereafter “Lenz,” in view of Official Notice. Claims 6, 19 and 32 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Lenz in view of Parkman (U.S. Patent Pub. No. 2003/0046375), hereafter “Parkman.” Claims 14, 27 and 40 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Lenz in view of Hesse (U.S. Patent No. 5,950,010), hereafter “Hesse.”

Applicants submit that these rejections are clearly not proper and without basis because at least one claim limitation is not met by the combined features of the references cited by the Office. As argued in the September 25, 2007 Amendment, the cited references fail to teach or suggest each and every element of independent claim 1. In particular, Lenz fails to teach or suggest a method for preserving hand-held mobile device user settings. September 25, 2007 Amendment, page 12, final paragraph through page 13, continued paragraph. The Office admits that Lenz does not explicitly teach this limitation, but instead takes Official Notice that wireless devices existed at the time of the Lenz invention, stating that it has given no weight to the words “hand held” because they are located in the preamble and indicating the KSR opinion abolished the need for a teaching suggestion or motivation to combine references. Applicants, however, submit that KSR, while modifying the test for determining whether references are combinable, states that “A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.” *KSR v. Teleflex*, 550 U. S. ____ (2007). As such, the Office’s use of the unrelated references of Lenz and Official notice is inappropriate. Further, Applicants submit that the limitation “hand-held mobile device” be given its full weight. Thus, the Office should be required to submit references that support this feature or withdraw the rejection.

As further argued in the September 25, 2007 Amendment, Lenz also fails to teach or suggest comparing time values of the updated properties file to time values of the client properties file in the application memory to determine whether the client properties have been changed by a user. The Office cites a passage of Lenz that describes comparing versions of particular software. However, the versions of Lenz are not compared to determine whether client properties have been changed by a user, but rather whether the latest version of the software has

been pushed from the server to the client. See September 25, 2007 Amendment, page 13, final paragraph through page 14, end of continued paragraph. Furthermore, Applicants disagree with the Office's contention that a time value of an application is inextricably linked to the version number. This is because a version of particular software may be completely independent of the time in which it was created as a developer may choose to implement a version prior to a previously created version. On the other hand, checking for time values may indicate that a file has changed even if its version, if any, remains the same, for example, in the case of a hot fix. As such, the comparing of the claimed invention is not merely of version numbers to determine whether software needs to be replaced with an updated version as in Lenz, but rather time values of the updated properties file are compared to time values of the client properties file to determine whether the client properties have been changed by a user.

As further argued in the September 25, 2007 Amendment, Lenz also fails to teach or suggest reconciling the updated properties file with the client properties file in the client database to yield a reconciled properties file to retain changes made to the client properties file by a user. In contrast, Lenz does not take into consideration whether the client properties file has been changed by the user, but rather, has as its focus making sure that the most current version of the server software is pushed from the server to the client. See September 25, 2007 Amendment, page 13, final paragraph through page 14, end of continued paragraph. As such, Lenz does not attempt to retain such changes to the client properties file, but rather, simply overwrites them with the newest version. As such, the reconciling in the claimed invention is done in such a way that changes made to the client properties file by a user are retained and does not merely blindly replace one version with another as does Lenz.

Accordingly, the Office has failed to state a prima facie case of anticipation, and this application is not in condition for appeal and should either be allowed as is, or re-opened for further prosecution.

With respect to the rejections of other independent claims, Applicants note that each claim includes a feature similar in scope to the features of claim 1. Further, the Office relies on the same arguments and interpretations of the cited references as discussed above with respect to claim 1. To this extent, Applicants herein incorporate the arguments presented above with respect to claim 1, and respectfully request withdrawal of the rejections of these claims for the above-stated reasons.

The dependent claims are believed to be allowable based on the above arguments regarding the claims from which they depend, as well as for their own additional features.

Applicants respectfully submit that the application is not in condition for appeal. Should the examining panel believe that anything further is necessary to place the application in better condition for allowance or for appeal, they are requested to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,



Date: January 11, 2007

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